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| 10/698,403 | 11/03/2003 | Guillaume Cassin | 231062US0 | 2866 |
| 22850 7590 06/13/2011 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | | |
| EXAMINER CRUZ, KATHLEEN ANN | | | | |
| ART UNIT 1628 | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/698,403

Applicant(s)

CASSIN, GUILLAUME

Examiner

KATHRIEN CRUZ

Art Unit

1628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claims 1-20 are pending.

Applicants response dated February 4, 2011 has been received and entered in the application.

Upon careful consideration, the finality of the Office Action dated August 5, 2010 has been vacated due to applicant's persuasive arguments.

Priority

This application claims benefit of provisional application 60/428741 (dated 11/25/2002).

Action Summary

Claims 1-20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Caisey et al. (US Patent No. 5587170), in view of Goodwin. (US Patent No. 3819825) and further in view of Alexander et al. (US Patent No. 2892797) is withdrawn.

Response to Arguments

Applicants argue that the Examiner recognized that the primary reference Caise2 neither teaches nor suggests treating greasy skin, the required silica/alumina composite, or the required thickening hydrocolloid. (Office Action at 9). Thus, the

primary reference is completely irrelevant to these invention methods. This argument has been fully considered and has been persuasive. However, Menda teaches a method of slowing the development of oily skin comprises applying to skin, which normally becomes oily, an oil-free suspension of pyrogenic colloidal silica (0.5-10 wt. %) in water (20-70 wt. %), a 2-4C aliphatic monohydric alcohol (25-75 wt. %) and an organic thickening agent (0.2-5 wt. %). Menda teaches that the hydrocolloids that are most preferably employed are the carboxymethyl celluloses and other thickening agents are polyvinylpyrrolidone, various acrylates, polyacrylates (column 4, lines 55-65). Menda teaches that the thickener should be of the organic type and from 0-10% of the composition (column 8, lines 9-12).

Applicants argue that Goodwin requires formation of a white film on skin, followed by rinsing, to treat greasy skin. (1 et seq.). Such a multi-step process is significantly longer and more cumbersome than the simple application involved in the invention methods and, in fact, teaches away from the claimed "consisting of" methods. Further, the fact that Goodwin teaches a composition which forms a white film on skin which must be removed demonstrates that Goodwin's compositions, and the ingredients therein, are completely different from the "leave-on" compositions used in the invention methods. This argument has been fully considered but has not been found persuasive. It is irrelevant that the composition of Goodwin teaches that forms a white film on the skin and has to be washed off because the instant claims does not specify when the composition is leave on or washed off. Therefore, the claims of treating greasy skin have been met. Additionally, the multi-step process which is significantly long in the

teachings of Goodwin is irrelevant because the instant claims do not specify a time period in which the treatment of skin is accomplished.

Applicants argue that Alexander does not teach or suggest treating greasy skin. This argument has been fully considered and has been found to be persuasive. However, in the new rejection Alexander is not included in the rejection and therefore the arguments are moot.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Menda et al (U.S. Patent 4,000,317) and Caisey et al. (US Patent No. 5587170) of record, in view of Goodwin. (US Patent No. 3819825) of record and further in view of Miyazaki (EP 1 066 818) of record.

Menda teaches a method of slowing the development of oily skin comprises applying to skin, which normally becomes oily, an oil-free suspension of pyrogenic colloidal silica (0.5-10 wt. %) in water (20-70 wt. %), a 2-4C aliphatic monohydric alcohol (25-75 wt. %) and an organic thickening agent (0.2-5 wt. %). Menda teaches that colloidal silicas indentified as Quso silicas, made by the Philadelphia Quartz Company, may be employed in partial replacement of the present pyrogenic silicas (column 3, lines 20-24). Menda teaches that the pyrogenic colloidal silica should be very small and uniformly in partical size (column 2, lines 17-20). Menda teaches that the particle size of the colloidal silica should be from 2 to 20 millimicrons, corresponding to the diameters of the spheres (column 2, lines 29-30). Menda teaches that the hydrocolloids that are most preferably employed are the carboxymethyl celluloses and other thickening agents are polyvinylpyrrolidone, various acrylates, polyacrylaces (column 4, lines 55-65). Menda teaches that the thickener should be of the organic type and from 0-10% of the composition (column 8, lines 9-12). Menda teaches that the pH of the composition should be between 3 and7, preferably between 4-6. Menda teaches that proportions of colloidal silica as high as 25% can be employed and in some situation greater proportions are usable, generally the colloidal

silica comprises from 1.5 to 10% of the liquid or solid composition (column 7, lines 9-13).

Menda does not teach that the colloidal particles being a silica/alumina composite filler.

Caisey et al. teach, in the abstract, use of a colloidal suspension based on inorganic fillers, which can be prepared by the sol-gel process as a cosmetic composition for treating the **skin**, hair and/or nails. In col. 1 lines 5-40, Caisey et al. disclose that skin treated with the colloidal suspension is more matt and thereby visually disguising wrinkles. In col. 2 lines 1-60, Caisey et al. disclose that the colloidal suspensions comprise metal oxide particles such as Al_2O_3 , TiO_2 , SiO_2 etc...The metal oxide particles form the inorganic filler and the inorganic filler has a particle size of between 1nm and 300nm and preferably 5nm to 100nm. In col. 3 lines 10-35, Caisey et al. discloses that the colloidal suspensions can have the inorganic fillers in suspension in concentrations between 0.001-25% by weight and that the pH of the compositions is generally between 5 and 10. The compositions can also contain silicones, non-ionic polymers, polyvinyl alcohol, polyvinylpyrrolidone, polyvinylbutyral and/or glycerols. Caisey teaches that metal oxides confer a matt appearance on the skin (claim 3).

Goodwin teaches a composition that treats oily skin comprising colloidal silica and a whole protein component of keratinaceous material (column 1, lines 50 - column 2, lines 1-6). Goodwin teaches that the colloidal— silica suspension may vary from 10% to about 49% and the pH is in the range of 5.50 to 8.5 (column 4, lines 40-45). Goodwin

teaches that "Ludos HS-40" by E. I. du Pont de Nemours and company, and having a particle size range of 13-14 μ m, pH 9.7, viscosity 17.5 centipoises, silica content 40.0 wt percent, specific surface are 21—230 sq. m. per gm., stabilized in sol form with sodium hydroxide as the alkaline agent in a ration of $\text{SiO}_2/\text{Na}_2\text{O}$ by weight of 93 (column 4, lines 20-27).

Miyazaki teaches a titanium oxide as well as Aluminum oxide (paragraph 0016) coating layer having the prespecified thickness can be obtained by dispersing a scaled substrate in water, and adding a prespecified quantity of metal salt such as titanyl sulfate into the solution for hydrolysis under alkaline atmosphere to have hydrolyte of the metal salt precipitated on a surface of the scaled substrate. , the silica coating layer with a prespecified thickness can be formed, for instance, by adding a prespecified quantity of aqueous Solution of alkali metal silicate or a prespecified quantity of organic silicon compound or the like into a dispersion of a scaled substrate with a coating layer having a higher refractive index than silica formed thereon, and further adding an acid or an alkali according to the necessity to have a silicate polymer (hydrolyzed condensate/polymer) deposited on a surface of the scaled substrate with the coating layer or layers having been formed thereon. It is noted that any other method may be employed for forming a silica coating layer (paragraph 0027). Miyazaki teaches that the composition has improved dispersive property of coloring pigments and excellent capability of adhering to the human skin in cosmetics (paragraph 0002). Miyazaki teaches that the cosmetic according to the present invention includes at least one of various components included in ordinary cosmetics including, for instance, heavy

aliphatic alcohol; heavy aliphatic acids; oils such as ester oil, paraffin oil, and wax; alcohol such as ethyl alcohol, propyleneglycol, sorbitol, and glycerin; moisturizing agents such as mucopolysaccharides, collagens, PCA salt, and lactates; various types of nonion-based, cation-based, anion-based, or amphoteric surface surfactants; gums such as Arabian gum, xanthane gum, polyvinyl pyrrolidone, ethylcellulose, carboxymethylcellulose, carboxyvinyl polymer (paragraph 0037).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a silica sol colloidal dispersion to formulate a composition for use in the treatment of skin as a mattifying agent applied to an individual that has greasy skin as Menda and Caisey et al. compositions directed toward those uses respectively. It would have been obvious to one of ordinary skill that the pyrogenic colloidal silica as taught by Menda could be substituted with any suitable silica sol such as the alumina/silica sol disclosed by Miyazaki et al. One would have been motivated to use Miyazaki's alumina/silica sol due to its improved dispersive property of coloring pigments and excellent capability of adhering to the human skin in cosmetics.

For these reasons, the claimed subject matter is deemed to fail to be patentably distinguishable over the state of the art as represented by the cited reference. The claims are therefore, properly rejected under 35 U.S.C. 103. In light of the foregoing discussion, the Examiner concludes that the subject matter defined by the instant claims would have been obvious within the meaning of 35 USC 103(a).

From the teachings of the references, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention.

Therefore, the invention as a whole was *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

Conclusion

Claims 1-20 are rejected.

No claims are allowed.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KATHRIEN CRUZ whose telephone number is (571)270-5238. The examiner can normally be reached on Mon - Thurs 7:00am - 5:00pm with every Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brandon Fetterolf can be reached on (571) 272-2919. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/KATHRIEN CRUZ/
Examiner, Art Unit 1628

/Brandon J Fetterolf/
Supervisory Patent Examiner, Art Unit 1628